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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,393	09/23/2003	Jon Godston	010398-9065-02	2524

7590 07/02/2004  
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EXAMINER

ALIE, GHASSEM

ART UNIT	PAPER NUMBER
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3724

DATE MAILED: 07/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/668,393	Applicant(s) GODSTON ET AL.	
	Examiner Ghassem Alie	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 4/17/04.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) 1-7, 14-29, and 37 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 8-13, 30, 31, 33-36 and 39-43 is/are rejected.
- 7) ☒ Claim(s) 32 and 38 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 September 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>09/23/03</u> . | 6) <input type="checkbox"/> Other: _____  |

***Election/Restrictions***

1. Applicant's election of species I (Figs. 1-9) filed on 05/17/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claims 1-7, 14-29, and 37 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected inventions, there being no allowable generic or linking claim.

Claims 1-7, 14-29, and 37 are withdrawn from further consideration because they are drawn to non-elected species III (Figs. 11-14). Although, applicant has indicated that these claims read over the elected species I (Figs. 1-9), "a four-bar linkage" in claims 1, 14, 22, and 37 read on the non-elected species III (Figs. 11-14). The four-bar linkage 530, 531 is shown clearly in Fig. 13 of the drawing and it is described on page 27, paragraphs 90 and 91. The four-bar linkage only is being introduced and disclosed under the description of the non-elected species III. The linkage bar assembly in the elected species I (Figs. 1-9) is not the same as the linkage bar assembly in the non-elected species III (Figs. 11-14) which is referred to as a four-bar linkage. Therefore, the linkage bar assembly in the elected species I (Figs. 1-9) is not a four-linkage bar and it is not being defined or described as a four-linkage bar in the specification.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 10-12 and 33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Regarding claims 10-12, "the support portion is oriented at an angle to a vertical" is not clear. It is not clear which vertical axis or line makes an angle with the upright support portion. Regarding claim 33, "the paper tray" lacks antecedent basis.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claim 8 is rejected under 35 U.S.C. 102(b) as being anticipated by Cavill (1,728,475) or Scharer (4,465,399). Regarding claim 8, Cavill teaches a punch for punching at least one sheet of paper including a support portion 3 which includes an arcuate portion 15 configured to support a first surface of the sheet of paper in an arcuate punching position. The arcuate edge of the support portion 3 curves the sheet of paper downwardly and holds the sheet of paper in arcuate punching position. Cavill also teaches at least a punch mechanism 32, 25 operably associated with the support portion 3 to punch the sheet of paper upon actuation of the punch 25. See Figs. 1-3 in Cavill.

7. Claims 30, 31, 34-36, and 39 are rejected under 35 U.S.C. 102(b) as being anticipated by Land (4,294,152). Regarding claim 30, Land teaches punch 10 including a base 12, 16 and a support member 54 pivotally coupled to the base 12, 16 and configured to punch the sheet of paper. The base is defined by the combination of the side supports 16 and horizontal base

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12. Land also teaches a punch mechanism 72 positioned to punch the sheet of paper, a drive member 78 pivotally coupled to the base 12, 16, and an actuating member 88 pivotally coupled to the support member 54 and the drive member 78. Land also teaches that the actuating member 88 is movable between a first position and a second position such that when in the second position the drive member 78 engages the punch mechanism 72 to punch the sheet of paper. See Figs. 1-3 in Land.

Regarding claim 31, Land teaches everything noted above including that the base defined a first pivot axis 34 and a second pivot axis 34 spaced a distance from and substantially parallel to the first pivot axis 34.

Regarding claim 34, Land teaches everything noted above including that the punch mechanism includes moveable relative to the support member 78.

Regarding claim 35, Land teaches everything noted above including that the punch the drive member 78 engages the punch pin 72 to translate the punch pin along a punch path that is perpendicular to the sheet of paper.

Regarding claim 36, Land teaches everything noted above including that a plurality of punch mechanism 42. See Fig. 3 in Land.

Regarding claim 39, Land teaches everything noted above including that the punch mechanism is supported by the support member 54.

8. Claims 40-43 are rejected under 35 U.S.C. 102(b) as being anticipated by Walsh (3,590,484). Regarding claim 40, Walsh teaches a method of punching a hole in a sheet of paper 80 and the method includes the following steps: supporting the sheet of paper 80 in a punch position adjacent a punch mechanism 38; positioning a drive member 34 in a drive

position such that it is engageable with the punch mechanism 38; and moving an actuator 26 move the drive member toward the sheet and to move the sheet of paper 80 toward the drive member 34. The drive member is in engagement with the punch mechanism. However, the drive member 34 is not disengaged from the punching mechanism 38 and the disengagement of the drive member from the punching mechanism is not recited by the claim. Therefore, it is not necessary for the drive member to disengage from the punching mechanism.

Regarding claim 41, Walsh teaches everything noted above including that the method has a step of pivoting the drive member 34 toward the sheet of paper and pivoting the sheet of paper 80 toward the drive member 34.

Regarding claim 42, Walsh teaches everything noted above including that the method has a step of translating a portion of the punch mechanism 38 in a direction substantially perpendicular to the sheet of paper 80.

Regarding claim 43, Walsh teaches everything noted above including that the method has a step of moving the punch mechanism 38 toward the drive member 34. The punch mechanism 38 moves with and towards the drive member 34.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

Obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negative by the manner in which the invention was made.

10. Claims 8-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka et al. (3,921,487), hereinafter Otsuka in view of Murakami et al. (5,949,364), hereinafter

Murakami. Regarding claim 8, Ostuka teaches a punch for punching at least one sheet of paper including a support portion 8, 12, 16 which includes an arcuate portion. The perforated plate, the guide member 12, and the guide pieces 16 define the support portion. The upper section of the guide member 12 includes an arcuate portion. Ostuka also teaches at least a punch mechanism 7, 24 operably associated with the support portion 8, 12, and 16 to punch the sheet of paper upon actuation of the punch 7. See Figs. 1-4 in Otsuka. Otsuka does not expressly teach that the arcuate portion of the support member supports the sheet of material in an arcuate punching position. However, Official notice is taken that having an arcuate support portion for supporting the sheet of paper in an arcuate position does is not critical to the punching function and does not solve any stated problems. In addition, the use of guide pieces and tray having an arcuate surface to support the sheet of paper in an arcuate position is well known in the art such as taught by Murakami. Murakami teaches a tray or guide piece 800 which has an arcuate surface to support sheet of papers P in an arcuate position. See Fig. 1 Murakami. It would have been obvious to a person of ordinary skill in the art to provide an arcuate for surface Otsuka's guide piece such as taught by Murakami as an alternative way to support the sheet of paper which can lean the sheet of paper backward away from the punching device and prevent the sheet of paper from leaning over the punching assembly or falling possibly on the punching assembly.

Regarding claim 9, Otsuka teaches everything noted above including that the support portion 8, 12, 16 is oriented upright to allow gravity to assist positioning the paper against the support portion.

Regarding claim 10-12, as best understood, Otsuka teaches everything noted above including that the support portion 8, 12, 16 is oriented at an angle to a vertical line perpendicular to the support bar or base 5. Otsuka also teaches that the angle is about less than 40 degrees from the vertical line. The angle appears to be 45 degrees from the vertical line. See Fig. 2 in Otsuka. In addition, Official notice is taken that the support members which are oriented upright to an angle less than 25 degrees or less than 45 degrees to the vertical line perpendicular to the base is well known in the art and is evident in patent to Scharer (4,645,399) or Hu (5,575,188) or Becker (2,421,864). Becker's support portion is even adjustable relative to the vertical line which is perpendicular to the base of a punching device.

Regarding claim 13, Otsuka as modified by Murakami teaches everything noted above including that more than one-third of the support portion 800 is arcuate. See Fig. 1 in Murakami.

#### **Allowable Subject Matter**

11. Claim 32 and 38 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. The following is a statement of reasons for the indication of allowable subject matter: the prior art fails to teach that the support member pivots about the first pivot axis and the drive member pivots about the second pivot axis as set forth in claim 32. The prior art also fails to teach a tray supported by the support member and operable to support the sheet of paper in a punch position.



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***Comment***

12. It is noted the claim 33 has not been rejected over prior art. However, in view of the issues under 35 U.S.C. 112, second paragraph, the allowability of the subject matter cannot be determined at this time.

***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Hart (2,191,382), Becker (2,421,864), Ginson (5,377,415), Lalonde et al. (3,805,652), Corsello (4,910,955), Musil (5,170,924), Baumuller (6,033,354), Scharer (4,645,399), Hu (5,575,188), Huang (5,664,473), Segal (2,482,218) teach a punching device with pivoting means.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ghassem Alie whose telephone number is (703) 305-4981. The examiner can normally be reached on Mon-Fri 8:30 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on (703) 305-1082. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9302 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

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GA/ga

June 24, 2004



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